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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,298	10/16/2001	Ryuichiro Maeyama	110894	4681

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EXAMINER
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KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb11

# Office Action Summary

Application No.

09/977,298

Applicant(s)

MAEYAMA ET AL

Examiner

Kevin R Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17, 18, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16, 19-21, 24, and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims 1-8, 17, 18, 22, and 23 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Status of Papers***

2. The amendments filed September 17, 2003 has been entered.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 9-13, 16, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saeki (US 6,336,025B1) in view of Buchan et al (US 3,923,392) for reasons of record.

5. Claims 9-13, 16, and 19-21 under are rejected under 35 U.S.C. 103(a) as being unpatentable over Saeki (US 6,336,025B1) in view of Goto (US 5,172,173) for reasons of record.

6. Claims 14, 15, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saeki (US 6,336,025B1) in view of Goto et al (US 5,172,173) or Buchan et al (US 3,923,392), as applied above, and further in view of Ohtani et al (US 5,534,581) for reasons of record.

7. The rejection of claims 9-14, 16, 19, 20, 24, and 25 under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al (US 6,376,594B1) in view of Buchan et al (US 3,923,392). 4, lines 1+) has been overcome by argument.
8. The rejection of claims 9-14, 16, 19, 20, 24, and 25, under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al (US 6,376,594B1) in view of Goto et al (US 5,172,173) has been overcome by argument.
9. The rejection of claims 15, 24, and 25 under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al (US 6,376,594B1) in view of Goto et al (US 5,172,173) or Buchan et al (US 3,923,392), as applied above, and further in view of Ohtani et al (US 5,534,581) has been overcome by argument.

### ***Response to Arguments***

Applicant's arguments filed September 17, 2003 have been fully considered but they are not persuasive.

Applicant argues that Saeki fails to teach or suggest a conductive material biased to one surface of the heat resistant film. The examiner respectfully disagrees. Saeki teaches that the transfer belt is made by centrifugally molding a blend of resin and conductive material (col 16, lines 33+). Centrifugal molding is known to cause a gradient in electrical resistance between the external and internal surfaces of a belt due to the difference in specific gravity between the different materials admixed (see US 6,139,784; col 1, lines 15+).

Applicant argues that Saeki teaches away from having a conductive material biased to one surface of the film. Specifically, at column 16, lines 42-49, Saeki teaches

that the belt is made so that the electrically conductive material is “uniformly dispersed and oriented in the liquid material.” The examiner takes the position that Applicant has misinterpreted the teachings of Saeki. The uniform dispersion that Saeki refers to is in the circumferential direction. Specifically, Saeki teaches that centrifugal molding results in “uniformly dispersed and oriented” conductive material that does not exhibit deviation as a result of pressing force applied onto the liquid material (col 16, lines 41+). The “pressing force” is a reference to the force applied during extrusion molding processes that results in non-uniform resistance in the circumferential direction (col 2, lines 37-60). Thus, Saeki does not teach away from the claimed invention.

Applicant further argues that the teachings of Goto would not have motivated one of ordinary skill in the art to apply a metal layer to the film of Saeki because Goto teaches that such metal-coated transfer belts have certain deficiencies. The examiner respectfully disagrees. While Goto teaches that such metal-coated transfer belts suffer some problems, Goto recognizes that metal coatings solve the “charge up” problem typically seen in transfer belts. Thus, Goto does provide motivation for applying the metal coating to the transfer belt of Saeki.

With regards to Ohtani, Applicant argues that the reference fails to correct the deficiencies of Saeki in view of Goto or Buchan. Since the examiner maintains the position that Saeki in view of Goto or Buchan renders the claimed invention obvious, the rejections based upon Ohtani are also maintained.

With regards to Sasagawa in view of Buchan and/or Goto, Applicant argues that Sasagawa does not teach or suggest that the conductive member may be used as a

Art Unit: 1773

transfer member. After reviewing the reference, the examiner agrees with Applicant's reading of Sasagawa. Thus, the rejections based upon Sasagawa have been overcome.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Art Unit: 1773

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*X-RK*

krk  
November 21, 2003

*Paul Thibodeau*  
Paul Thibodeau  
Supervisory Patent Examiner  
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